

Knobbe Martens Olson & Bear LLP

Intellectual Property Law

550 West C Street
Suite 1200
San Diego CA 92101
Tel 619-235-8550
Fax 619-235-0176
www.kmob.com

Ryan E. Melnick, Ph.D.
619-525-8319
rmelnick@kmob.com

July 24, 2009

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Re: Title: HYDROXY-AMINO ACID AMIDES
Letters Patent No. 5,892,038
Issued: April 6, 1999
Attorney Docket: LIGAND.076A2

Dear Sir:

Enclosed for filing is a Certificate of Correction in connection with the above-identified patent. Applicants respectfully request to invoke the procedures set forth in M.P.E.P 1481.03(II)(A), which allow the use of a Certificate of Correction to correct a claim for 35 U.S.C. 120 benefits for applications filed before November 29, 2000.

All conditions of 37 CFR 1.78(a)(1) in the version of 37 CFR 1.78 in effect as of November 29, 2000 have been met. Furthermore, it is clear from the record that the above-identified patent was intended to be a divisional application of the parent application No. 08/743,944 filed on November 5, 1996 (now U.S. Patent No. 5,734,054 issued March 31, 1998). In support of the Certificate of Correction, enclosed please also find the New Utility Patent Application Transmittal, a preliminary amendment, and an Information Disclosure Statement filed with the application on December 8, 1997, and an Office Action response filed by Applicants on July 20, 1998, all demonstrating that the above-identified patent was filed as a divisional of the application No. 08/743,944.

Specifically, the New Utility Patent Application Transmittal indicates that the above-identified patent was filed as a divisional of Application No. 08/743,944. It also indicates that a copy of the Declaration filed in Application No. 08/743,944 was being filed in view of the divisional status of the application. In the preliminary amendment, Applicants explicitly states "[t]his Preliminary Amendment is being file contemporaneously with a divisional application under 37 CFR § 1.53(b) of the United States Patent Application 08/743,944 (the "parent application")." Moreover, the Information Disclosure Statement indicates that copies of the cited references for the present application may be found in prior Application 08/743,944 in view of the divisional status of the application. In the Office Action response dated July 20, 1998, Applicants responded to a double patenting rejection based on Application No. 08/743,944 by

Orange County
949-760-0404

San Francisco
415-954-4114

Los Angeles
310-551-3450

Riverside
951-781-9231

Seattle
206-405-2000

Washington, DC
202-640-6400

July 24, 2009

Page -2-

noting that the present application was a divisional of the cited application. Thus, the record is clear that priority to Application No. 08/743,944 is appropriate.

As the errors cited in the Certificate of Correction were not incurred through the fault of the Office, enclosed is our check in the amount of \$100. Please charge any additional fees to our Deposit Account No. 11-1410.

Respectfully submitted,

Knobbe, Martens, Olson & Bear, LLP



Ryan E. Melnick
Registration No. 58,621
Customer No. 20,995

Enclosures

7514828
072209

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT NO. : 5,892,038
APPLICATION NO. : 08/986,545
ISSUE DATE : April 6, 1999
INVENTOR(S) : Dolle et al.

Page 1 of 1

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

At Column 1, after the Title "HYDROXYL-AMINO ACID AMIDES," please insert

-- CROSS-REFERENCE TO RELATED APPLICATIONS

The present application is a Divisional of U.S. Patent Application Serial No. 08/743,944, filed on November 5, 1996 (now U.S. Patent No. 5,734,054 issued March 31, 1998). --.

7514599
072209

MAILING ADDRESS OF SENDER:

Ryan E. Melnick
KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 Main Street, 14th Floor
Irvine, California 92614

DOCKET NO. LIGAND.076A2

Express Mail Label No. EM356312311US

12/08/97

**NEW UTILITY PATENT APPLICATION TRANSMITTAL
(Small Entity)**

(Only for new nonprovisional applications under 37 CFR 1.53(b))

Docket No.
PH1015DB

Total Pages in this Submission
72

TO THE ASSISTANT COMMISSIONER FOR PATENTS

Box Patent Application
Washington, D.C. 20231

Transmitted herewith for filing under 35 U.S.C. 111(a) and 37 C.F.R. 1.53(b) is a new utility patent application for an invention entitled:

HYDROXY-AMINO ACID AMIDES

and invented by:

Roland Ellwood Dolle, III, Hitesh K. Patel, Theodore O. Johnson, Jr.,
Carolyn DiIanni Carroll, Shiwei Tao

If a **CONTINUATION APPLICATION**, check appropriate box and supply the requisite information:

☐ Continuation ☒ Divisional ☐ Continuation-in-part (CIP) of prior application No.: 08/743,944

Enclosed are:

Application Elements

1. ☒ Filing fee as calculated and transmitted as described below
2. ☒ Specification having 51 pages and including the following:
 - a. ☒ Descriptive Title of the Invention
 - b. ☐ Cross References to Related Applications (if applicable)
 - c. ☐ Statement Regarding Federally-sponsored Research/Development (if applicable)
 - d. ☐ Reference to Microfiche Appendix (if applicable)
 - e. ☒ Background of the Invention
 - f. ☒ Brief Summary of the Invention
 - g. ☐ Brief Description of the Drawings (if drawings filed)
 - h. ☒ Detailed Description
 - i. ☒ Claim(s) as Classified Below
 - j. ☒ Abstract of the Disclosure
3. ☐ Drawing(s) (when necessary as prescribed by 35 USC 113)
 - a. ☐ Formal
 - b. ☐ Informal

Number of Sheets _____

NEW UTILITY PATENT APPLICATION TRANSMITTAL
(Small Entity)

(Only for new nonprovisional applications under 37 CFR 1.53(b))

Docket No.
PH1015DB

Total Pages in this Submission
72

Application Elements (Continued)

4. ☒ Oath or Declaration
- a. ☐ Newly executed (*original or copy*) ☐ Unexecuted
- b. ☒ Copy from a prior application (37 CFR 1.63(d)) (*for continuation/divisional application only*)
- c. ☒ With Power of Attorney ☐ Without Power of Attorney
5. ☒ Incorporation By Reference (*usable if Box 4b is checked*)
The entire disclosure of the prior application, from which a copy of the oath or declaration is supplied under Box 4b, is considered as being part of the disclosure of the accompanying application and is hereby incorporated by reference therein.
6. ☐ Computer Program in Microfiche
7. ☐ Genetic Sequence Submission (*if applicable, all must be included*)
- a. ☐ Paper Copy
- b. ☐ Computer Readable Copy
- c. ☐ Statement Verifying Identical Paper and Computer Readable Copy

Accompanying Application Parts

8. ☐ Assignment Papers (*cover sheet & documents*)
9. ☐ 37 CFR(B) Statement (*when there is an assignee*)
10. ☐ English Translation Document (*if applicable*)
11. ☒ Information Disclosure Statement/PTO-1449 ☐ Copies of IDS Citations
12. ☒ Preliminary Amendment
13. ☒ Acknowledgment postcard
14. ☒ Certificate of Mailing
☐ First Class ☒ Express Mail (*Specify Label No.*): EM356312311US
15. ☐ Certified Copy of Priority Document(s) (*if foreign priority is claimed*)
16. ☐ Small Entity Statement(s) - Specify Number of Statements Submitted: _____

NEW UTILITY PATENT APPLICATION TRANSMITTAL
(Small Entity)

(Only for new nonprovisional applications under 37 CFR 1.53(b))

Docket No.

PH1015DB

Total Pages in this Submission

72

Accompanying Application Parts (Continued)

17. ☒ Additional Enclosures (please identify below):

Associate Power of Attorney (37 CFR 1.34)

Fee Calculation and Transmittal

CLAIMS AS FILED

For	#Filed	#Allowed	#Extra	Rate	Fee
Total Claims	12	- 20 =	0	x \$11.00	\$0.00
Indep. Claims	1	- 3 =	0	x \$41.00	\$0.00
Multiple Dependent Claims (check if applicable) <input type="checkbox"/>					\$0.00
BASIC FEE					\$395.00
OTHER FEE (specify purpose)					\$0.00
TOTAL FILING FEE					\$395.00

- ☒ A check in the amount of \$395.00 to cover the filing fee is enclosed.
- ☒ The Commissioner is hereby authorized to charge and credit Deposit Account No. 16-1448 as described below. A duplicate copy of this sheet is enclosed.
- ☐ Charge the amount of _____ as filing fee.
- ☒ Credit any overpayment.
- ☒ Charge any additional filing fees required under 37 C.F.R. 1.16 and 1.17.
- ☐ Charge the issue fee set in 37 C.F.R. 1.18 at the mailing of the Notice of Allowance, pursuant to 37 C.F.R. 1.311(b).

Dated:

December 8, 1997

CERTIFICATE OF MAILING (37 CFR 1.10)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10, on the date shown below and is addressed to the Assistant Commissioner for Patents, Box Patent Application, Washington, D.C. 20231.

Date: 12/8/97

Janet Rubinstein

(Name of person mailing paper)

Janet B. Rubinstein
(Signature of person mailing paper)

Vicki H. Audia
Signature

Vicki H. Audia, Ph.D.
Agent for Applicant
Registration No. 34,539
Pharmacopeia, Inc.
101 College Road East
Princeton, NJ 08540

#2/7

Express Mail No. EM356312311US
PH1015DB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Dolle et al.
Serial No. : Unknown
Filed : December 8, 1997
For : HYDROXY-AMINO ACID
AMIDES
Group Art Unit :
Examiner :

0896545-120897

CERTIFICATE OF MAILING (37 CFR 1.10)	
I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10, on the date shown below and is addressed to the Assistant Commissioner for Patents, Box Patent Application, Washington, D.C. 20231.	
Date: 12/8/97	<u>Janet B. Rubinstein</u> (Type or print name of person mailing paper) <u>Janet B. Rubinstein</u> (Signature of person mailing paper)

Princeton, NJ 08540
December 8, 1997

To: Assistant Commissioner for Patents
Washington, D.C. 20231

PRELIMINARY AMENDMENT

Dear Sir:

Entry of this Preliminary Amendment prior to
examination on the merits is respectfully requested.

Please amend the above-identified application as
follows:

PH1015DB

IN THE SPECIFICATION:

Page 5, line 6, change "2-amino-3,4-dimethylpentanoic acid" to --isoleucine--.

REMARKS

This Preliminary Amendment is being filed contemporaneously with a divisional application under 37 CFR § 1.53(b) of United States Patent Application 08/743,944 (the "parent application"). As originally filed, the parent application presented claims 1-12. A Restriction Requirement, dated April 11, 1997 in the parent application, divided the claims into three groups, as follows:

I. Claims 1-2 and 4-12 (in part), drawn to compounds of formula I where Y is R⁵ and R⁵ represents a pyrrolidine, classified in class 548.

II. Claims 1-2 and 4-12 (in part), drawn to compounds of formula I where Y is R⁵ and R⁵ represents a piperazine, classified in class 544, as noted in Examiner's action, dated June 12, 1997 in the parent application.

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Express Mail No. EM356312311US
PH1015DB

III. Claims 1, 3 and 7-9 (in part), drawn to compounds of formula I where Y is R⁴, classified in various classes and subclasses.

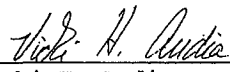
In response to the Restriction Requirement, applicants elected and prosecuted the claims of Group II in the parent application.

Support for the amendment to the specification is found at page 5, line 6; page 7, lines 13-14; and page 4, lines 10-13. The Examiner's Amendment, dated October 10, 1997 in the parent Application supports the change to the specification on page 5, line 6. No new matter has been added.

Applicants respectfully request a favorable action in the present application.

Respectfully submitted,

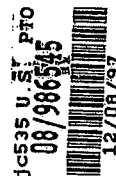
Dated: December 8, 1997


Vicki H. Audia
Agent For Applicant
Registration No. 34,539
Pharmacopeia, Inc
101 College Road East
Princeton, NJ 08540

08986545-120897

Attorney's Docket No. PH1015DB

Express Mail No. EM356312311US
PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Dolle et al.
Serial No. : Not yet known
Filed : December 8, 1997
For : Hydroxy-Amino Acid Amides
Group Art Unit :
Examiner :

CERTIFICATE OF MAILING (37 CFR 1.10)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10, on the date shown below and is addressed to the Assistant Commissioner for Patents, Box Patent Application, Washington, D.C. 20231.

Janet B. Rubinstein

(Type or print name of person mailing paper)

Date: 12/8/97

Janet B. Rubinstein

(Signature of person mailing paper)

The Assistant Commissioner for Patents
Washington, D.C. 20231

INFORMATION DISCLOSURE STATEMENT

Dear Sir:

This Information Disclosure Statement is submitted:



under 37 CFR 1.97(b), or

(Within three months of filing national application; or date of entry of international applications; or before mailing date of first office action on the merits; whichever occurs last)



under 37 CFR 1.97(c) together with either:

- ☐ a certification under 37 CFR 1.97(e), or
☐ a \$200.00 fee under 37 CFR 1.17(p), or
(After the CFR 1.97(b) time period, but before final action or notice of allowance, whichever occurs first)

- ☐ under 37 CFR 1.97(d) together with:
☐ a Certification under 37 CFR 1.97(e), and
☐ a petition under 37 CFR 1.97(d)(2)(ii), and
☐ a \$130.00 petition fee set forth in 37 CFR 1.17(I)(1).
(Filed after final action or notice of allowance, whichever occurs first, but before payment of the issue fee)

Method of Fee Payment:

- ☐ Enclosed is a check in the amount of \$_____.
☐ Please charge Deposit Account 16-1448 in the amount of \$_____.
☒ Two duplicate copies of this Statement are enclosed.
☒ Please charge any deficiency in fees or credit any overpayment to Deposit Account 16-1448.

Enclosed herewith is form PTO-1449:

- ☐ Copies of the cited references are enclosed.
☒ Copies of the cited references may be found in prior application U.S. Serial No. 08/743,944.
☐ The listed references were cited in the enclosed International Search Report in a counterpart foreign application.

It is requested that the information disclosed herein be made of record in this application.

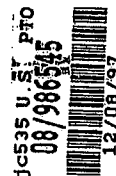
Respectfully submitted,

Date: December 8, 1997

Vicki H. Audia
Vicki H. Audia, Ph.D.
Registration No.: 34,539
Agent for Applicants
PHARMACOEPIA, INC.
101 College Road East
Princeton, NJ 08540
Telephone: (609) 452-3609

Attorney's Docket No. PH1015DB

Express Mail No. EM356312311US
PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Dolle et al.
Serial No. : Not yet known
Filed : December 8, 1997
For : Hydroxy-Amino Acid Amides
Group Art Unit :
Examiner :

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Janet B. Rubinstein

(Type or print name of person mailing paper)

Date: 12/8/97

Janet B. Rubinstein

(Signature of person mailing paper)

The Assistant Commissioner for Patents
Washington, D.C. 20231

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This Information Disclosure Statement is submitted:

- ☒ under 37 CFR 1.97(b), or
(Within three months of filing national application; or date of entry of international applications; or before mailing date of first office action on the merits; whichever occurs last)
- ☐ under 37 CFR 1.97(c) together with either:

- ☐ a certification under 37 CFR 1.97(e), or
☐ a \$200.00 fee under 37 CFR 1.17(p), or
(After the CFR 1.97(b) time period, but before final action or notice of allowance, whichever occurs first)

- ☐ under 37 CFR 1.97(d) together with:
☐ a Certification under 37 CFR 1.97(e), and
☐ a petition under 37 CFR 1.97(d)(2)(ii), and
☐ a \$130.00 petition fee set forth in 37 CFR 1.17(I)(1).
(Filed after final action or notice of allowance, whichever occurs first, but before payment of the issue fee)

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☐ Please charge Deposit Account 16-1448 in the amount of \$_____.
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- ☐ Copies of the cited references are enclosed.
☒ Copies of the cited references may be found in prior application U.S. Serial No. 08/743,944.
☐ The listed references were cited in the enclosed International Search Report in a counterpart foreign application.

It is requested that the information disclosed herein be made of record in this application.

Respectfully submitted,

Date: December 8, 1997

Vicki H. Audia
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Registration No.: 34,539
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PHARMACOEPIA, INC.
101 College Road East
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Telephone: (609) 452-3609